

Remarks

Reconsideration of this application as amended is respectfully requested.

Claims 1-16 stand rejected under 35 U.S.C. §101.

Claims 1, 4-5, and 11 stand rejected under 35 U.S.C. §102(b) in view of Optimal Inventories based on Job Completion Rate for Repairs Requiring Multiple Items by Smith et al. ("Smith").

Claims 2-3, 6-10, and 12-21 stand rejected under 35 U.S.C. §103(a) in view of *Smith* and U.S. Patent No: 5,682,421 of *Glovitz et al.* ("Glovitz").

New claims 22-27 are added.

The examiner has objected to the title. In response, applicant has provided a new title.

The examiner has rejected claims 1-16 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicant respectfully submits that claims 1-16 recite a practical application of predicting parts needed for a repair and are therefore statutory under 35 U.S.C. §101. For example, predicting parts needed for a repair is a practical invention because the selection of parts taken to an onsite repair impacts the time and costs of performing the onsite repair. (See page 1 of applicant's specification and page 849, first paragraph of the Introduction of *Smith*).

The examiner has set forth a two-pronged test of determining whether a patent is eligible subject matter under 35 U.S.C. §101. (See page 2, Office Action, 9-26-05). However, the technological arts test that the examiner has set forth has been invalidated. See *Ex Parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005) in which the Board stated that "Our determination is that there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter

under § 101. We decline to create one."

Applicant submits that amended claim 1 is not anticipated by *Smith* because *Smith* does not disclose a method for predicting parts needed for a repair including determining an expected waste for a set of parts that may be replaced during the repair in response to a repair history for the product as claimed in amended claim 1. The examiner has acknowledged that *Smith* does not teach analyzing a repair history. (Page 10, second paragraph Office Action, 9-26-05).

Given that claim 2-16 depend from amended claim 1, it follows that claims 2-16 are not anticipated by *Smith*.

Applicant also submits that amended claim 1 is not obvious in view of *Smith* and *Glovitz* because *Smith* and *Glovitz* do not disclose or suggest predicting parts needed for a repair by determining an expected waste for a set of parts of that may be replaced during the repair in response to a repair history as claimed in amended claim 1. *Smith* discloses determining an optimal parts stocking policy by determining a penalty cost L in response to the cost of machine downtime, lost repairman time, and trips to a supply depot (*Smith*, Page 850, second and third paragraphs) rather than determining an expected waste for a set of parts in response to a repair history as claimed in amended claim 1.

Glovitz does not disclose a method for predicting parts needed for a repair in response to a repair history as claimed in amended claim 1. *Glovitz* teaches managing an inventory in response to repair records (*Glovitz*, col. 1, lines 53-61) but does not disclose how repair records are used in inventory management. Moreover, *Glovitz* does not disclose that inventory management includes predicting parts needed for onsite repair as claimed in amended claim 1. Instead, *Glovitz* discloses a service dispatch and

management system that collects repair records and states that

This system may be integrated with a wide range of other systems to manage accounting and inventory. (Glovitz, col. 1, lines 59-61). This suggests that the managing of inventory in response to repair records as taught by *Glovitz* is managing stockroom inventory rather than a predicting parts needed for onsite repair as claimed in amended claim 1 because the service dispatch and management system of *Glovitz* must be integrated with accounting and inventory systems to provide the accounting and inventory systems with repair records. In any event, *Glovitz* like *Smith* does not teach predicting parts needed for a repair by determining an expected waste for a set of parts of that may be replaced during the repair in response to a repair history as claimed in amended claim 1.

Furthermore, *Smith* does not teach or suggest a combination with *Glovitz* and *Glovitz* does not teach or suggest a combination with *Smith*. Instead, the thrust of the teachings in *Smith* are directed to maintaining optimal inventories for use in field repairs whereas the thrust of the teachings in *Glovitz* are directed to an automated dispatch system for service technicians.

Given that claim 2-16 depend from amended claim 1, it follows that claims 2-16 are not obvious in view of *Smith* and *Glovitz*.

It is also submitted that amended claim 17 is not anticipated by *Smith* or obvious in view of *Smith* and *Glovitz* because amended claim 17 includes limitations similar to the limitations of amended claim 1. Therefore, the remarks stated above with respect to amended claim 1 also apply to amended claim 17.

Given that claim 18-21 depend from amended claim 17,

it follows that claim 18-21 are not anticipated or obvious in view of the references cited by the examiner.

It is further submitted that new claims 22-27 are not anticipated by *Smith* or obvious in view of *Smith* and *Glovitz* because new claims 22-27 include limitations similar to the limitations of amended claim 1. Therefore, the remarks stated above with respect to amended claim 1 also apply to new claims 22-27.

It is respectfully submitted that in view of the amendments and arguments set forth above, the applicable objections and rejections have been overcome.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 08-2025 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 1-26-06 By: Paul H. Horstmann
Paul H. Horstmann
Reg. No.: 36,167